

REMARKS

The Official Action of August 26, 2004 has been carefully considered and reconsideration of the application as amended is respectfully requested.

Claim 4 has been amended with the incorporation therein of recitations formerly in claim 13 (now canceled), which recite the presence in the claimed composition of di(tri) ethylene glycol monobutyl ether and (di)propylene glycol monobutyl ether. The lower limits of these claimed compounds draw support from the specification as filed at Examples 7 to 14, wherein these are disclosed as the lower limits of the recited compounds in the referenced examples. Claim 9 has been canceled whereby to remove the basis for the objection appearing at paragraph 2 of the Official Action.

The claims as amended are respectfully believed to be free of the rejections under 35 USC 102 and 103 appearing at paragraphs 3-9 of the Official Action. To arrive at the claimed invention, one of skill in the art would have to pick and choose from a vast number of possible combinations of components, including optional components, and ranges of components disclosed in the cited references. However, as discussed in Applicants' Amendment filed May 24, 2004, the cited art does not show the criticality of including the claimed saccharide-alkyleneoxy derivative into the claimed ink in the recited amount. Under these circumstances, it is respectfully submitted that the cited art cannot anticipate or render obvious the claimed compositions. See *In re Baird*, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994); see, also,

MPEP Section 2144.05 (“if the reference’s disclosed range is so broad as to encompass a very large number of possible distinct compositions, this might present a situation analogous to the obviousness of a species when the prior art broadly discloses a genus.”)

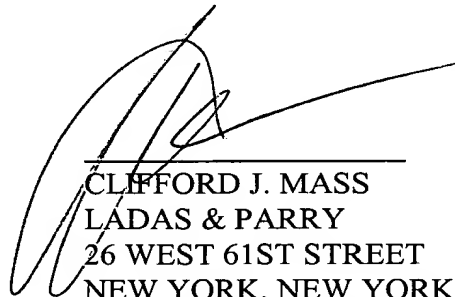
With specific respect to the Examiner’s argument that Iwata et al teach the claimed range with sufficient specificity to anticipate under 35 USC 102, Applicant respectfully disagrees. As made clear in MPEP 2131.03, what constitutes “sufficient specificity” is fact dependent and must be decided on the specific facts of each case. Applicant respectfully submits that the relative size of the claimed range of the recited saccharide-alkenoxy derivative as compared with the range described in Iwata et al, is not the proper inquiry where, as here, the claimed range and the **broad** range described in the reference touch only at an endpoint and the reference teaches a preference away from this broad range and toward a narrower range where there is no overlap. Given this preference, one of skill in the art cannot clearly envisage the claimed composition, which requires a selection not only of the endpoint of a range that the reference teaches is less preferred, but which also requires picking and choosing from a number of other components and combinations of components to arrive at the claimed invention. See *Baird* at page 1552 (“A disclosure of millions of compounds does not render obvious a claim to three compounds, particularly when that disclosure indicates a preference leading away from the claimed compounds.”).

With specific respect to the rejections under 35 USC 103, Applicant respectfully notes that there is a declaration showing unexpected results with the

claimed composition which rebuts any alleged *prima facie* case of obviousness based on the cited art (see Remarks in Amendment filed May 24, 2004). The Examiner has respectfully not provided any indication why the declaration would not be effective in overcoming any such *prima facie* case and it is respectfully submitted that these rejections should be withdrawn for this reason as well.

In view of the above, it is respectfully submitted that all rejections and objections of record have been overcome and that the application is now in allowable form. An early notice of allowance is earnestly solicited and is believed to be fully warranted.

Respectfully submitted,

A handwritten signature in black ink, appearing to be "Clifford J. Mass", is written over a horizontal line. The signature is stylized with a large loop and a long horizontal stroke extending to the right.

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